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Paper No. 25

**MAILED**

In re Application of :  
Michael REED et al. :  
Application No. 08/113,955 :  
Deposited: August 31, 1993 :  
Attorney Docket No. E4800.001P00 :

MAR 04 2009

ON PETITION **OFFICE OF PETITIONS**

This is a decision on the petitions filed February 6, 2008 and February 10, 2009 under 37 CFR 1.59 requesting that the third party submissions of January 9, 2008 and January 6, 2009 respectively, be expunged from the record. The petition of February 6, 2008 was only recently brought to the attention of the Office of Petitions by the indication in the February 10, 2009 petition that such petition had been granted; the delay in treatment of the petition is regretted.

The petitions are **DISMISSED**.

First, it should be noted that the petition submitted February 10, 2009 indicates that the petition filed February 6, 2008 had been granted; however, no record of such a grant can be found in the USPTO files.

37 CFR 1.291 states:

(a) A protest may be filed by a member of the public against a pending application, and it will be matched with the application file if it adequately identifies the patent application. A protest submitted within the time frame of paragraph (b) of this section, which is not matched in a timely manner to permit review by the examiner during prosecution, due to inadequate identification, may not be entered and may be returned to the protestor where practical, or, if return is not practical, discarded.

(b) The protest will be entered into the record of the application if, in addition to complying with paragraph (c) of this section, the protest has been served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and, except for paragraph (b)(1) of this section, the protest was filed prior to the date the application was published under § 1.211, or a notice of allowance under § 1.311 was mailed, whichever occurs first:

(1) If a protest is accompanied by the written consent of the applicant, the protest will be considered if the protest is matched with the application in time to permit review during prosecution.

(2)A statement must accompany a protest that it is the first protest submitted in the application by the real party in interest who is submitting the protest; or the protest must comply with paragraph (c)(5) of this section. This section does not apply to the first protest filed in an application.

(c)In addition to compliance with paragraphs (a) and (b) of this section, a protest must include.

(1)A listing of the patents, publication, or other information relied upon;

(2)A concise explanation of the relevance of each item listed pursuant to paragraph (c)(1) of this section;

(3)A copy of each listed patent, publication, or other item of information in written form, or at least the pertinent portions thereof;

(4)An English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information relied upon; and

(5)If it is a second or subsequent protest by the same party in interest, an explanation as to why the issue(s) raised in the second or subsequent protest are significantly different than those raised earlier and why the significantly different issue(s) were not presented earlier, and a processing fee under § 1.17(i) must be submitted.

(d)A member of the public filing a protest in an application under this section will not receive any communication from the Office relating to the protest, other than the return of a self-addressed postcard which the member of the public may include with the protest in order to receive an acknowledgement by the Office that the protest has been received. The limited involvement of the member of the public filing a protest pursuant to this section ends with the filing of the protest, and no further submission on behalf of the protestor will be considered, unless the submission is made pursuant to paragraph (c)(5) of this section.

(e)Where a protest raising inequitable conduct issues satisfies the provisions of this section for entry, it will be entered into the application file, generally without comment on the inequitable conduct issues raised in it.

(f)In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a protest.

(g)Protests that fail to comply with paragraphs (b) or (c) of this section may not be entered, and if not entered, will be returned to the protestor, or discarded, at the option of the Office.

MPEP 1901 states:

The degree of participation allowed a protestor is solely within the discretion of the Director of the USPTO.

37 CFR 1.291 gives recognition to the value of written protests in bringing information to the attention of the Office and in avoiding the issuance of invalid patents. With the exception of a protest accompanied by a written consent of the applicant, all protests must be submitted prior to the publication of the application or the mailing of a notice of allowance, whichever occurs first. No protest or other form of preissuance opposition to the grant of a patent may be initiated after publication of the application without the applicant's express written consent as specified by 35 U.S.C. 122(c).

A party obtaining knowledge of an application pending in the Office may file a protest against the application and may therein call attention to any facts within protestor's knowledge which, in the protestor's opinion, would make the grant of a patent on the application improper. The party should include with the protest whatever information the party is aware of that would facilitate identification of the application and matching the protest with the application. If there is insufficient information to identify the application, the protest may not be matched at all or not timely matched with the intended application to permit review by the examiner during prosecution of the application, in which case, the protest may not be entered and may be returned to the protestor where practical. If return is not practical, the protest will be discarded. 37 CFR 1.291(a). See MPEP § 1901.03. A protestor does not, by the mere filing of a protest, obtain the "right" to argue the protest before the Office. Active participation by a protestor ends with the filing of the protest, and no further submission on behalf of the protestor will be considered, unless the submission is made pursuant to 37 CFR 1.291(c)(5). See 37 CFR 1.291(d). The USPTO will acknowledge the receipt of a protest in an original or a reissue application file, only if a self-addressed postcard is included with the protest (see MPEP § 1901.05). The question of whether or not a patent will issue is a matter between the applicant and the Office acting on behalf of the public.

MPEP 1901.02 states:

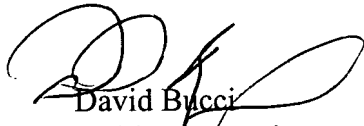
Any information which, in the protestor's opinion, would make the grant of a patent improper can be relied on in a protest under 37 CFR 1.291. While prior art documents, such as patents and publications, are most often the types of information relied on in protests, 37 CFR 1.291 is not limited to prior art documents. Protests may be based on any facts or information adverse to patentability.

37 CFR 1.59 provides for the applicant's request for expungement of information in a patent application, other than the original papers upon which the filing date was granted. However, under the terms of the rule, petitioner "must ...establish to the satisfaction of the Director that the expungement of the information is appropriate..." See 37 CFR 1.59(b). Under the circumstances of this case, petitioner has not met his burden of proof.

With respect to the first protest submitted January 9, 2008, the petition, filed February 6, 2008, to expunge this protest is dismissed. Protester has complied with the provisions of 37 CFR 1.291. The protest will remain in the record; however, in accordance with 37 CFR 1.291 the protestor does not have the right to argue the protest before the Office.

With respect to the second protest submitted January 6, 2009, the petition, filed February 10, 2009, to expunge this protest is dismissed. Protester has complied with the provisions of 37 CFR 1.291. The protest will remain in the record; however, in accordance with 37 CFR 1.291 the protestor does not have the right to argue the protest before the Office.

Telephone inquiries related to this decision may be addressed to the undersigned at (571) 272-7099.



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